

DETAILED ACTION

1. Claims 1-7 are pending.
2. In the response filed December 1, 2008, Applicants have elected Group I, claims 1 and 5-7, with traverse. The chemical compound of claim 4, (4-Benzyl-oxo-benzyl)- (thiophen-2-ylmethyl)-amine, is the preferred species.
3. Based upon the response, the restriction requirement and species election are withdrawn.
4. Claims 2-4 provide for the use of the compound, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claims 2-4 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

The recitation of the term “use” renders the claims non-statutory.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
6. Claims 1 and 5-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- A. At claim 1, it is suggested that the term “general” should be deleted.
- B. At claim 1, it is suggested that the phrase “and the pharmaceutically acceptable salts” should be amended to read in the alternative.
- C. At claim 1, the proviso is unclear. The proviso states
Het cannot be indole, benzo[b]furan, benzo[b]thiophen, chroman, when
R₅ and R₆ are both hydrogen, or 2-pyridyl. R₅ and R₆ do not represent 2-pyridyl.
Clarification is appreciated.

- D. Claims 5-7 improper depend upon claim 1. See B above.
- E. Claim 7 is identical to claim 1.

7. The Information Disclosure Statement filed April 13, 2006 has been considered. The references alone or in combination forms do not teach nor suggest the invention as instantly claimed. There is no motivation to modify the prior art compounds to derive the claimed compounds. Accordingly, no rejections based upon prior art are made.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Zinna Northington Davis whose telephone number is 571-272-0682.

9. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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/Zinna Northington Davis/
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Znd
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